Remarks

35 U.S.C. § 103 Rejection of Claims

In the 12 July 2006 Office Action, claims 36 - 71 are rejected as being unpatentable over Marshall (US Patent 6,073,115) in view of Krishnaswamy (U.S. Patent 6,909,708). The Examiner has cited Marshall and Krishnaswamy as reference documents.

The Assignee respectfully traverses the § 103 rejections of claims 36 - 71 in two ways. First, by noting that the 12 July 2006 Office Action fails under both tests established by the Administrative Procedures Act. Second, by noting that the 12 July 2006 Office Action cites a combination of documents that fails to establish a prima facie case of obviousness. More specifically, the Office Action fails to establish a prima facie case of obviousness in at least four ways:

1. by citing a combination of documents that teach away from the proposed combination;
2. by citing a combination of documents fails to meet any of the criteria for establishing a prima facie case of obviousness;
3. by citing a combination of documents fails to make the invention as a whole obvious, and
4. by citing a combination of documents that require a change in the principle of operation of each of the cited documents.

The Assignee also notes that there are still other ways in which all § 103 obviousness rejections in the 12 July 2006 Office Action for claims 36 - 71 can be traversed.

As discussed previously, the first way the cited combination of documents fails to establish a prima facie case of obviousness is that it cites a combination of documents that teach away from the proposed combination. MPEP § 2145 X.D.2 provides that: "it is improper to combine references where the references teach away from their combination." The cited documents teach away from the proposed combination in a number of ways including:

1. Incompatible system topologies. Marshall teaches the use of Dynamic Data Exchange (hereinafter, DDE) for obtaining data from other systems (Marshal C5, L50 - 60 and C11, L20 - 25). It is well known to those of average skill in the art that DDE is a mechanism for linking two applications on the same

computer together in order to exchange data (see Visual Automation) At the same time, Krishnaswamy teaches distributed data management (Krishnaswamy, C38, L47 - C39, L 68). More specifically, Krishnaswamy teaches that "data is stored at many locations simultaneously" using distributed databases (Krishnaswamy, C39, L 5 - 6). It clearly would be improper to combine an invention that teaches and relies on the data being present on a single computer with a system that teaches and relies on data being stored in distributed databases resident on many computers.

2. Incompatible data management. Marshall teaches the use of DDE (Marshal C5, L50 - 60 and C11, L20 - 25). It is well known to those of average skill in the art that DDE is a method for obtaining data on an item at a time basis usually by spreadsheet cell (see Visual Automation). At the same time Krishnaswamy teaches the use of distributed data storage which includes automated replication and synchronization in accordance with a common schema (Krishnasway, C39 L14 - 19). It clearly would be improper to combine an invention that teaches and relies on obtaining data one item at a time basis with an invention that teaches and relies on database level replication and synchronization.
3. Incompatible focus. Marshall teaches a virtual reality generator for abstract pheonomena (Marshall, Title). Marshall goes on to state that "the information displayed in (the) virtual reality world created by the present invention is abstract information about the real world that does not have a physical object equivalent in the real world (Marshall, Column 3, lines 49 – 54). At the same time, a primary use of the Krishnaswamy invention is "routing telephone calls, data and other multimedia information including video, audio and data." (Krishnaswamy, Abstract). The information routed by Krishnaswamy all have physical object equivalents in the real world. It clearly would be improper to combine an invention that teaches the display of abstract information that does not have a physical object equivalent in the real world with a system for managing information related to entities with physical object equivalents in the real world.

As discussed previously, the second way the 12 July 2006 Office Action fails to establish the prima facie case of obviousness required to sustain § 103 rejections of claim 36 - 71 is that if fails to meet any of the criteria for establishing a prima facie case of

obviousness. MPEP 2142 provides that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. As detailed below, the 12 July 2006 Office Action fails to meet all three of the criteria for establishing a prima facie case of obviousness for claims 36 - 71:

1. The 12 July 2006 Office Action fails to meet the first criteria for establishing a prima facie case of obviousness for claims 36 - 71 because the two documents (Marshall and Krishnaswamy) teach away from the theoretical combination contained in the Office Action as described previously. It is well established that "teachings of references can be combined only if there is some suggestion or incentive to do so" quoting ACS Hosp. Sys., Inc. v Montefiore Hosp., 732 F.2d 1572, 1577 221 U.S.PQ 929,933 (Fed. Cir. 1984). Another reason the proposed theoretical combination fails to meet the first criteria is that there is no incentive to make the combination.
2. The 12 July 2006 Office Action fails to meet the second criteria for establishing a prima facie case of obviousness for claims 36 - 71 because it does not cite a combination of teachings that has a reasonable expectation of success. There are at least two reasons why the cited combination of documents does not have a reasonable expectation of success. The first reason the combination would be expected to fail is that the cited documents have many incompatible characteristics that teach away from the proposed combination as described previously. The second reason is that the Office Action does not teach how a system routing telephone calls, data and other multimedia information and a virtual reality system could be combined to produce anything useful. It is well established that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). In spite of this well know requirement, the Office Action has not described how the teachings of these references would be combined or the reason for doing so.

3. The 12 July 2006 Office Action fails to meet the third criteria for establishing a prima facie case of obviousness because it does not teach or suggest one or more limitations for every claim.

Far from establishing a prima facie case of obviousness for claims 36 - 71, the cited combination of documents in the 12 July 2006 Office Action provides additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. It does this by calling for a combination of documents when the cited documents teaches away from their proposed combination, by advocating a combination of documents that is an almost certain failure and by relying on a combination of documents that fails to suggest or make obvious almost all of the claim limitations.

The third way the combination of documents cited 12 July 2006 Office Action fails to establish a prima facie case of obviousness for claims 36 - 71 is that it fails to make the invention as a whole obvious as required by MPEP § 2141.02 which states that:

> In determining the difference between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious but whether the claimed invention as a whole would have been obvious.

As noted previously, the obviousness rejections are based on a combination of Marshall and Krishnaswamy. Marshall and Krishnaswamy each teach away from the method of the instant application in a number of ways. As noted previously, the two documents also teach away from their own combination and the Examiner has failed to identify any possible reasons for combining the two inventions. Taken together the cited combination of documents fails to make the invention as a whole obvious. The cited combination also fails to make a single aspect of the claimed invention obvious. These failures provide additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious.

The fourth way the 12 July 2006 Office Action fails to establish a prima facie case of obviousness is that the proposed combination would change the principle of operation of each of the cited documents. MPEP 2143.01 states that "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)". The proposed combination would change the principle of operation of each document cited as a reference as described below:

1. Change from visualization of abstract phenomena to analysis of real world elements of value. Marshall teaches a virtual reality generator for abstract pheonomena (Marshall, Title). Marshall goes on to state that "the information displayed in (the) virtual reality world created by the present invention is abstract information about the real world that does not have a physical object equivalent in the real world (Marshall, Column 3, lines 49 – 54). The Examiner has proposed using this invention in combination with Krishnaswamy to among other things render obvious an invention for identifying a tangible, real world impact of a plurality of real world elements of value including brands, customers and employees. Modifying Marshall to evaluate or analyze real world elements of value would require a change in principle in the operation of the Marshall invention. As a result, the teachings of the cited combination of documents are not sufficient to render the claims prima facie obvious.
2. Change from distributed data storage to centralized data storage. Krishnaswamy teaches distributed data management (Krishnaswamy, C38, L47 - C39, L 68). More specifically, Krishnaswamy teaches that "data is stored at many locations simultaneously" using distributed databases (Krishnaswamy, C39, L 5 - 6). The Examiner has proposed using this invention in combination with Marshall to among other things render obvious an invention for integrating data from a plurality of systems in accordance with a common xml schema and storing the integrated in a single application database. Modifying Krishnaswamy to rely on a single, centralized database would require a change in principle in the operation of the Krishnaswamy invention. As a result, the teachings of the cited combination of documents are not sufficient to render the claims prima facie obvious.
3. Change from inter-connected applications to independent software components. Marshall teaches the use of Dynamic Data Exchange (hereinafter, DDE) for obtaining data from other systems (Marshal C5, L50 - 60 and C11, L20 - 25). It is well known to those of average skill in the art that DDE is a mechanism for linking two applications on the same computer together in order to exchange data (see Visual Automation). The Examiner has proposed using this invention in combination with Krishnaswamy to among other things render obvious an invention for using independent components for producing tangible, concrete and useful results. Modifying Marshall to use independent components instead of linked applications would require a change in principle in the operation of the Marshall invention. As a

result, the teachings of the cited combination of documents are not sufficient to render the claims prima facie obvious.

The Assignee notes again that there are still other ways in which all §103 obviousness rejections in the 12 July 2006 Office Action for claims 36 – 71 can be traversed.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

> In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. In fact the opposite is true as the prosecution to date of this application and the referenced applications in the CIP chain has produced documents that disclose several hundred instances of novelty, non-obviousness and newness relative to the state of the art in the claimed methods and systems (multiple instances of the same teaching are counted multiple times). A large part of the prior art traversals that generated this overwhelming evidence of novelty, non-obviousness and newness consisted of showing that the combination of patents proposed by the Examiners to support an obviousness rejection taught away from the proposed combination – just as they do in the instant application. In fact, this Office Action is also the 23rd Office Action in a row where the combination of documents used to support a § 103 rejection teach away from the proposed combination. Patents are documents that teach those of average skill in the art how to make and practice an invention. Understanding how to make and practice an invention includes an understanding of the teachings of an invention and how those teachings would enable or prevent combinations with other inventions. Having said that, the Assignee notes that the primary reasons a few claims were amended was to correct clerical errors and to put the claims into final form for allowance and issue.

Information Disclosure Statements

The Assignee respectfully requests that copies of all previously submitted information disclosure statement forms be initialed and returned as soon as possible.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,

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